TABLE OF CONTENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	:	Customer Number: 46320
	:	
Imaddin ALBAZZ, et al.	:	Confirmation Number: 3924
	:	
Application No.: 09/972,403	:	Group Art Unit: 3689
	:	
Filed: October 5, 2001	:	Examiner: M. Meyers
	:	
For: SYSTEM AND METHOD FOR WORKFLOW CONTROL OF CONTRACTUAL ACTIVITIES		

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed March 13, 2008, and in response to the Examiner reopening prosecution in the Office Action dated June 19, 2008, wherein Appellants appeal from the Examiner's rejection of claims 1, 3, 5-11, 13-19, 21-25, 27, 29-35, and 37-40.

I. REAL PARTY IN INTEREST

This application is assigned to IBM Corporation by assignment recorded on October 5, 2001, at Reel 012242, Frame 0776.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1, 3, 5-11, 13-19, 21-25, 27, 29-35, and 37-40 are pending and three-times rejected in this Application. Claims 2, 4, 12, 20, 26, 28, and 36 have been cancelled. It is from the multiple rejections of claims 1, 3, 5-11, 13-19, 21-25, 27, 29-35, and 37-40 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

The claims have not been amended subsequent to the imposition of the Third Office Action dated June 19, 2008 (hereinafter the Third Office Action).

V. SUMMARY OF CLAIMED SUBJECT MATTER

1   Referring to Figure 8 and also to independent claim 1, a system for workflow control of

2   contractual activities under a contract comprising a predefined set of terms and conditions is

3   disclosed. The system includes a computer and a communication interface. Referring to Fig. 10,

4   the computer stores the contract terms and conditions, references information, and references the

5   terms and conditions of the contract to process the information and generate a user interface in

6   response (page 22, line 20 through page 23, line 2). The communications interface

7   communicates the user interfaces to a contracting party, and the user interface displays selected

8   information based on terms and conditions in the contract (page 22, line 20 through page 23, line

9   2). Referring to Figures 3 and 9, the contract is generated by as follows. At least one

10 compilation of business rules comprising a plurality of rules available to be selected for inclusion

11 in the contract is stored (page 13, lines 8-17). At least one terms and conditions set containing

12 parameters corresponding to selected rules from the compilation of business rules are stored

1   (page 17, lines 9-19). Links are generated between the compilation of business rules and the

2   terms and conditions set to generate specific terms and conditions to be embodied in the contract

3   (page 21, lines 1-5). The compilation of business rules, the terms and conditions set and the

4   links are interlocked to lock the contract (page 21, lines 6-10; page 25, lines 1-7).

5   Referring to independent claim 9, a method of workflow control of contractual activities

6   under a contract comprising a predefined set of terms and conditions is disclosed. Referring to

7   Fig. 10, the contract terms and conditions are stored, information is received, and the terms and

8   conditions of the contract are referenced to process the information and generate user interfaces

9   in response (page 22, line 20 through page 23, line 2). The user interface is communicated to a

10   contracting party (page 22, line 20 through page 23, line 2). Referring to Figures 3 and 9, the

11   contract is generated by as follows. At least one compilation of business rules comprising a

12   plurality of rules available to be selected for inclusion in the contract is stored (page 13, lines 8-

13   17). At least one terms and conditions set containing parameters corresponding to selected rules

14   from the compilation of business rules are stored (page 17, lines 9-19). Links are generated

15   between the compilation of business rules and the terms and conditions set to generate specific

16   terms and conditions to be embodied in the contract (page 21, lines 1-5). The compilation of

17   business rules, the terms and conditions set and the links are interlocked to lock the contract

18   (page 21, lines 6-10; page 25, lines 1-7).

19   Referring to independent claim 17, a computer program product for use with a computer,

20   the computer program product comprising a computer usable medium having computer readable

21   program code embodied in said medium for workflow control of contractual activities under a

22   contract comprising a predefined set of terms and conditions is disclosed. Referring to Fig. 10,

23   the contract terms and conditions are stored, information is received, and the terms and

1   conditions of the contract are referenced to process the information and generate user interfaces

2   in response (page 22, line 20 through page 23, line 2). The user interfaces is communicated to a

3   contracting party (page 22, line 20 through page 23, line 2). Referring to Figures 3 and 9, the

4   contract is generated by as follows. At least one compilation of business rules comprising a

5   plurality of rules available to be selected for inclusion in the contract is stored (page 13, lines 8-

6   17). At least one terms and conditions set containing parameters corresponding to selected rules

7   from the compilation of business rules are stored (page 17, lines 9-19). Links are generated

8   between the compilation of business rules and the terms and conditions set to generate specific

9   terms and conditions to be embodied in the contract (page 21, lines 1-5). The compilation of

10   business rules, the terms and conditions set and the links are interlocked to lock the contract

11   (page 21, lines 6-10; page 25, lines 1-7).

12   Referring to independent claim 25, a processing system for workflow control of

13   contractual activities under a contract comprising a predefined set of terms and conditions is

14   disclosed. Referring to Fig. 10, a storage module stores the contract terms and conditions; a

15   receiving module receives information; a reference module references the terms and conditions

16   of the contract to process the information and generate a user interface in response; the

17   communications interface communicates the user interfaces to a contracting party; and the user

18   interface displays selected information based on terms and conditions in the contract (page 22,

19   line 20 through page 23, line 2). Referring to Figures 3 and 9, the contract is generated by as

20   follows. At least one compilation of business rules comprising a plurality of rules available to be

21   selected for inclusion in the contract is stored (page 13, lines 8-17). At least one terms and

22   conditions set containing parameters corresponding to selected rules from the compilation of

23   business rules are stored (page 17, lines 9-19). Links are generated between the compilation of

1   business rules and the terms and conditions set to generate specific terms and conditions to be

2   embodied in the contract (page 21, lines 1-5). The compilation of business rules, the terms and

3   conditions set and the links are interlocked to lock the contract (page 21, lines 6-10; page 25,

4   lines 1-7).

5   Referring to independent claim 33, a program product for use with a computer having

6   computer readable program code for workflow control of contractual activities under a contract

7   comprising a predefined set of terms and conditions is disclosed. Referring to Fig. 10, the

8   contract terms and conditions are stored, information is received, and the terms and conditions of

9   the contract are referenced to process the information and generate user interfaces in response

10   (page 22, line 20 through page 23, line 2). The user interfaces is communicated to a contracting

11   party (page 22, line 20 through page 23, line 2). Referring to Figures 3 and 9, the contract is

12   generated by as follows. At least one compilation of business rules comprising a plurality of

13   rules available to be selected for inclusion in the contract is stored (page 13, lines 8-17). At least

14   one terms and conditions set containing parameters corresponding to selected rules from the

15   compilation of business rules are stored (page 17, lines 9-19). Links are generated between the

16   compilation of business rules and the terms and conditions set to generate specific terms and

17   conditions to be embodied in the contract (page 21, lines 1-5). The compilation of business

18   rules, the terms and conditions set and the links are interlocked to lock the contract (page 21,

19   lines 6-10; page 25, lines 1-7).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

   1. Claims 9-11, 13-16, 25, 27, and 29-32 were rejected under 35 U.S.C. § 101; and

   2. Claims 1, 3, 5-11, 13-19, 21-25, 27, 29-35, and 37-40 were rejected under 35 U.S.C. §

102 for anticipation based upon Conklin et al., U.S. Patent No. 6,338,050 (hereinafter Conklin).

VII. ARGUMENT

1   Prior to address the individual rejections, Appellants note that in reopening prosecution in

2   the Fifth Office Action, the Examiner only modified the rejection of claims 3, 11, 19, 27, and 35

3   and added a new rejection under 35 U.S.C. § 101. Otherwise, the rejections of the claims remain

4   the same from the Examiner's Second Office Action. Despite the extensive arguments presented

5   in the First Appeal Brief dated March 13, 2008 (hereinafter First Appeal Brief), the Examiner did

6   not even attempt to respond to these arguments.

7

8   Appellants presume that the Examiner's failure to respond to Appellants' arguments in the

9   First Appeal Brief was intentional and for the purpose of introducing a new rejection under 35

10   U.S.C. § 101 without having to subject the Examiner's analysis as to the remaining rejections to

11   scrutiny twice more (i.e., after the Third Office Action reopening prosecution and after the

12   Examiner's Answer). Instead, by essentially ignoring Appellants' arguments in the First Appeal

13   Brief, the Examiner's response will only be scrutinized after the Examiner has prepared the

14   Examiner's Answer. In this regard, Appellants proceed under the assumption that the Examiner

15   will be kind enough to share the Examiner's rationale for maintaining the prior rejections.

16   However, since Appellants do not have an Examiner's "Response to Remarks" to respond to,

17   Appellants can only repeat the arguments previously presented in the First Appeal Brief and

18   respond to the new rejection under 35 U.S.C. § 101 and the modified rejection of claims 3, 11,

19   19, 27, and 35.

20

1   **THE REJECTION OF CLAIMS 9-11, 13-16, 25, 27, AND 29-32 UNDER 35 U.S.C. § 101**

2   For convenience of the Honorable Board in addressing the rejections, claims 10-11 and

3   13-16 stand or fall together with independent claim 9, and claims 27 and 29-32 stand of fall

4   together with independent claim 25.

5

6   <u>Claim 9</u>

7   The crux of the Examiner's argument is found in the fourth enumerated paragraph on

8   page 4 of the Third Office Action and reproduced below:

9   Here, applicant's method steps, fail the first prong of the new Federal Circuit decision
10   since they are not tied to another statutory class and can be preformed [sic] without the use of a
11   particular apparatus. Thus, claims 9-16 are non-statutory since they may be preformed within the
12   human mind.
13
14 At the outset, Appellants note that the Examiner failed to identify "the new Federal Circuit

15   decision" upon which the Examiner is relying. The latest case identified on page 3 of the Third

16   Office Action is from 1981.

17

18   Notwithstanding the Examiner's yet-to-be-identified source of the case law described in

19   the third enumerated paragraph of the Third Office Action, reference is made to U.S. Patent No.

20   5,333,184 (hereinafter the '184 patent). Claim 1 of the '184 patent is reproduced below:

21   1.   A method for use in a telecommunications system in which interexchange
22   calls initiated by each subscriber are automatically routed over the facilities of a
23   particular one of a plurality of interexchange carriers associated with that
24   subscriber, said method comprising the steps of:
25   generating a message record for an interexchange call between an
26   originating subscriber and a terminating subscriber, and
27   including, in said message record, a primary interexchange carrier (PIC)
28   indicator having a value which is a function of whether or not the interexchange
29   carrier associated with said terminating subscriber is a predetermined one of said
30   interexchange carriers.
31

1   Upon reviewing this claim, it is readily apparent to a layman in the art that all of the method

2   steps recited in this claim could be performed within the human mind. Both a message record

3   and a PIC indicator are forms of data that can easily be generated within a human mind. Thus, if

4   the Examiner's analysis was followed at the time the application, which matured into the '184

5   patent, was examined, then this claim would have been rejected under 35 U.S.C. § 101.

6

7   Appellants have referred to the '184 patent because this patent was the subject of the

8   decision by the Federal Circuit in AT&T Corp. v. Excel Communications, Inc.[1] The conclusion

9   of the Federal Circuit with regard to the '184 patent is "we find that the claimed subject matter is

10 properly within the statutory scope of 101." The decision in AT&T Corp. is informative as to a

11 couple of the issues raised by the Examiner's analysis. First with regard to the concept of

12 transformation, the Federal Circuit stated the following:

13   Excel argues that method claims containing mathematical algorithms are patentable
14   subject matter only if there is a "physical transformation" or conversion of subject matter from one
15   state into another. The physical transformation language appears in Diehr, see 450 U.S. at 184
16   ("That respondents' claims involve the transformation of an article, in this case raw, uncured
17   synthetic rubber, into a different state or thing cannot be disputed."), and has been echoed by this
18   court in Schrader, 22 F.3d at 294, 30 USPQ2d at 1458 ("Therefore, we do not find in the claim any
19   kind of data transformation.").
20   The notion of "physical transformation" can be misunderstood. In the first place, it is not
21   an invariable requirement, but merely one example of how a mathematical algorithm may bring
22   about a useful application. As the Supreme Court itself noted, "when [a claimed invention] is
23   performing a function which the patent laws were designed to protect (e.g., transforming or
24   reducing an article to a different state or thing), then the claim satisfies the requirements of 101."
25   Diehr, 450 U.S. at 192 (emphasis added). The "e.g." signal denotes an example, not an exclusive
26   requirement.
27   This understanding of transformation is consistent with our earlier decision in
28   Arrhythmia, 958 F.2d 1053, 22 USPQ2d 1033 (Fed. Cir. 1992). Arrhythmia's process claims
29   included various mathematical formulae to analyze electrocardiograph signals to determine a
30   specified heart activity. See id. at 1059, 22 USPQ2d at 1037-38. The Arrhythmia court reasoned
31   that the method claims qualified as statutory subject matter by noting that the steps transformed
32   physical, electrical signals from one form into another form - a number representing a signal
33   related to the patient's heart activity, a non-abstract output. See id., 22 USPQ2d at 1038. The
34   finding that the claimed process "transformed" data from one "form" to another simply confirmed
35   that Arrhythmia's method claims satisfied 101 because the mathematical algorithm included within
36   the process was applied to produce a number which had specific meaning - a useful, concrete,
37   tangible result - not a mathematical abstraction. See id. at 1060, 22 USPQ2d at 1039.

---

[1] 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999).

1

2   As noted in the last sentence of this quote, the Federal Circuit held that the transformation of data

3   from one form to another is sufficient to satisfy the requirements of 35 U.S.C. § 101 so as to

4   produce data which had a specific meaning (i.e., a useful, concrete, tangible result) and not a

5   mathematical abstraction.

6

7   The steps of storing, generating, and interlocking all involve the transformation of data

8   from one state to another. With the storing step, data is transformed from residing in one

9   location (e.g., memory) to another location (e.g., a hard drive). With the generating step, old

10   data is transformed to create a new data construct of "links." With the interlocking step, old data

11   is transformed by the interlocking process, which also creates new data that interlocks the old

12   data. Therefore, a transformation has occurred which meets the requirements of 35 U.S.C. §

13   101. Appellants also note that the Examiner has not set forth any rationale or substantial

14   evidence as to why the claimed invention, as a whole, does not produce a useful, concrete, and

15   tangible result. Therefore, the Examiner has failed to establish a prima facie rejection under 35

16   U.S.C. § 101.

17

18   Regarding the assertion that the process be tied to another statutory class, Applicants

19   position is that the claimed invention, as recited in claim 9, is tied to two statutory classes. First,

20   claim 9 recites the step of storing the contract terms and conditions. The storage requires the use

21   of a storage device, which is a machine. Also, the communication of a user interface to a

22   contract party requires a device. The user interface is communicated with a device, and the user

23   interface itself requires a device to be seen. In this regard, reference is made to the recent

1   decision of the Federal Circuit of In re Comiskey,[2] in which a determination was made that

2   certain claims met the requirements of 35 U.S.C. § 101 based upon the broadest reasonable

3   interpretation of the claim language. The Federal Circuit reasoned, that under a broadest

4   reasonable interpretation, the claimed invention "could require the use of a computer." Based

5   upon the description found on page 12 of Appellants' disclosure, Appellants' position is that the

6   method could require the use of a computer. Thus, claim 9 is tied to a device.

7

8   Moreover, claim 9 is tied to a manufacture. Specifically, a data construct is a

9   manufacture. Claim 9 recites several instances of data constructions (e.g., contract terms and

10   conditions, at least one compilation of business rules, parameter corresponding to selected rules,

11   links) to which the process is tied. Thus, Appellants respectfully submit that the claimed

12   invention meets the requirement that the process be tied to another statutory class.

13

14   Claim 25

15   The Examiner's analysis with regard to claim 25 is found in the sixth enumerated

16   paragraph on page 6 of the Third Office Action. Although the Examiner's analysis implies that

17   the claims are directed to a computer program (i.e., "[t]o be statutory, a computer program must

18   be (1) coupled with or combined with some statutory physical structure ...), claim 25 is clearly

19   and unambiguously directed to a device. A storage module (e.g., a hard drive, memory, etc.) is a

20   device. Both the communications interface and receiving module are communication devices.

21   Also the user interface is a display device (e.g., a monitor). The reference module is a processor.

22   With regard to the reference module, the Federal Circuit in In re Comiskey made the

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[2] Appeal No. 2006-1286 (Fed. Cir. Sep. 20, 2007).

1   determination that a module can be "[a] self-contained hardware."   Thus, the Examiner's

2   assertion the claim 1 is not directed to a device (i.e., statutory subject matter) is clearly in error.

3

4   The Examiner's allegation that the claimed invention does not produce some useful,

5   concrete, and tangible result is merely conclusory without any supporting rationale or substantial

6   evidence in support.   Regarding the Examiner's assertion as to "non-functional descriptive

7   material," Appellants are entirely unclear as to what the Examiner is referring.   Claim 25 is

8   replete with functional language.   As such, Appellants' position is that the Examiner's rejection

9   of claim 25 is poorly reasoned.

10

11   **THE REJECTION OF CLAIMS 1, 3, 5-11, 13-19, 21-25, 27, 29-35, AND 37-40 UNDER 35**

12   **U.S.C. § 102 FOR ANTICIPATION BASED UPON CONKLIN**

13   For convenience of the Honorable Board in addressing the rejections, claims 3, 5-11, 13-

14   19, 21-25, 27, 29-35, and 37-40 stand or fall together with independent claim 1.

15

16   As is evident from Appellants' previously-presented comments during prosecution of the

17   present Application and from Appellants' comments below, there are questions as to how the

18   limitations in the claims correspond to features in the applied prior art.   In this regard, reference

19   is made to M.P.E.P. § 1207.02, entitled "Contents of Examiner's Answer."   Specifically, the

20   following is stated:

21   (A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's
22   answer is required to include, under appropriate headings, in the order indicated, the following
23   items:
24   ...
25   (9)(e) For each rejection under 35 U.S.C. 102 or 103 where there are questions
26   as to how limitations in the claims correspond to features in the prior art even after the
27   examiner complies with the requirements of paragraphs (c) and (d) of this section, the
28   examiner must compare at least one of the rejected claims feature by feature with the

1   prior art relied on in the rejection. The comparison must align the language of the claim
2   side-by-side with a reference to the specific page, line number, drawing reference
3   number, and quotation from the prior art, as appropriate. (emphasis added)

4

5   Therefore, if the Examiner is to maintain the present rejections and intends to file an Examiner's

6   Answer, the Examiner is required to include the aforementioned section in the Examiner's

7   Answer.

8

9   The factual determination of anticipation under 35 U.S.C. § 102 requires the <u>identical</u>

10   disclosure, either explicitly or inherently, of <u>each</u> element of a claimed invention in a single

11   reference.[3] Moreover, the anticipating prior art reference must describe the recited invention

12   with sufficient clarity and detail to establish that the claimed limitations existed in the prior art

13   and that such existence would be recognized by one having ordinary skill in the art.[4] As part of

14   this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the

15   meaning of the elements in light of the specification and prosecution history, and (c) identify

16   corresponding elements disclosed in the allegedly anticipating reference.[5] This burden has not

17   been met.

18

19   At the outset, Appellants note that independent claims 1, 9, 17, 25, and 33 have been

20   amended to respectively include the limitations previously presented in claims 4, 12, 20, 28, and

21   36. Specifically claims 4, 12, 20, 28, and 36 each recite the following limitations:

22   the contract is generated by:

---

[3] <u>In re Rijckaert</u>, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); <u>Richardson v. Suzuki Motor Co.</u>, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); <u>Perkin-Elmer Corp. v. Computervision Corp.</u>, 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).
[4] <u>See</u> <u>In re Spada</u>, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); <u>Diversitech Corp. v. Century Steps, Inc.</u>, 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).
[5] <u>Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co.</u>, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

1   storing at least one compilation of business rules comprising a plurality of

2   rules available to be selected for inclusion in the contract,

3   storing at least one terms and conditions set containing parameters

4   corresponding to selected rules from the compilation of business rules,

5   generating links between the compilation of business rules and the terms

6   and conditions set to generate specific terms and conditions to be embodied in the

7   contract, and

8   interlocking the compilation of business rules, the terms and conditions set

9   and the links to lock the contract.

10

11   On page 4 of the First Office Action, to teach <u>all</u> of the above-reproduced limitations, the

12   Examiner asserted the following:

13   (Conklin Col. 19, lines 38-56, "Sponsor 06 also monitors activity, collects fees, establishes
14   standards or rules (or both) for the community, and promotes successes.").
15
16   For ease of reference, column 19, lines 38-56 is reproduced below:

17   The sponsor processes of FIG. 1g include maintaining databases, registering community
18   and seller domain names, and submitting Web uniform resource locators (URLs) to multiple
19   search engines so that both the community Website and each seller Website within it can be found
20   by search engines such as Compaq's ALTAVISTA.TM. among others. Sponsor 06 also monitors
21   activity, collects fees, establishes standards or rules (or both) for the community, and promotes
22   successes. Once a deal is concluded it is archived 68, by multivariate negotiations engine 212 on
23   behalf of seller. The present invention also allows the collection and analysis of direct e-mail
24   demographic information, such as company name, title and location. This data helps the present
25   invention screen out frivolous or fraudulent inquirers. For example, a high school student
26   attempting to propose an order might be intercepted when the present invention determines that no
27   company name or title has been provided and no other authorization for such a request has been
28   provided for.
29

30   Appellants respectfully disagree with the Examiner's analysis. In this regard, Appellants note the

31   Examiner's rejection under 35 U.S.C. § 102 fails to comply with 37 C.F.R. § 1.104(c).[6] Although

32   broadly identifying in Conklin where the Examiner believes the claimed limitations are

---

[6] 37 C.F.R. § 1.104(c) provides:

        In rejecting claims for want of novelty or for obviousness, the examiner must cite the best
    references at his or her command. When a reference is complex or shows or describes inventions
    other than that claimed by the applicant, the particular part relied on must be designated as nearly
    as practicable. The pertinence of each reference, if not apparent, must be clearly explained and
    each rejected claim specified.

1   disclosed, the manner in which the Examiner conveyed the statement of the rejection, however,

2   has not "designated as nearly as practicable" the <u>particular</u> <u>parts</u> in Conklin being relied upon in

3   the rejection.

4

5   For example, as claimed, the contract is generated is two separate storing steps: a

6   generating step, and an interlocking step. However, the Examiner's cited passage is silent as to

7   these specific limitations. Thus, the Examiner has failed to establish that Conklin identically

8   discloses the claimed invention, as recited in independent claims 1, 9, 17, 25, and 33, within the

9   meaning of 35 U.S.C. § 102.

10

11   The above-reproduced arguments were previously presented on pages 12-14 of the

12   Amendment dated September 28, 2007 (hereinafter the First Amendment).   The Examiner

13   responded to these arguments on pages 6-8 of the Second Office Action in the "Response to

14   Arguments" section. For ease of reference, the Examiner's comments are reproduced below.

15   Initially, the Examiner asserted the following:

16   Examiner cites particular columns and line numbers in the references as applied to the
17   claims for the convenience of the applicant. Although the specified citations are representative of
18   the teachings in the art and are applied to the specific limitations within the individual claim, other
19   passages and figures may apply as well. It is respectfully requested that, in preparing responses,
20   the applicant fully consider the references in entirety as potentially teaching all or part of the
21   claimed invention, as well as the context of the passage as taught by the prior art or disclosed by
22   the examiner.
23
24   The above-reproduced passage is commonly found in Office Actions. Although not present in this

25   instances, this passage is also commonly found in conjunction to a citation to M.P.E.P. § 2123 for

26   the proposition that a references are "relevant for all they contain." However, like most instances in

27   which this phrase is employed, the Examiner has misused this phrase. In particular, although a

28   reference may be relevant for all that it contains, the Examiner still has the burden of identifying,

1   within the prior art, those specific teachings the Examiner is relying upon to identically disclose

2   each of the claimed limitations.

3

4   The Examiner cannot simply dispense with the specificity requirements by noting that a

5   reference is relevant for all it contains. The importance of the specificity requirement of 37 C.F.R.

6   § 1.104(c) is evident in M.P.E.P. § 706.07, which states:

7
8   The examiner should never lose sight of the fact that in every case the applicant is entitled to a full
9   and fair hearing, and that a clear issue between applicant and examiner should be developed, if
10   possible, before appeal.

11   A clear issue, however, cannot be developed between Appellants and the Examiner where the

12   basis for the Examiner's rejection of the claims is <u>ambiguous</u>. The Examiner's "analysis"

13   provides little insight as to (i) how the Examiner is interpreting the elements of the claims and

14   (ii) what <u>specific</u> features within Conklin the Examiner believes identically discloses the <u>specific</u>

15   elements (and interactions between elements) recited in the claims. By failing to specifically

16   identify those features within Conklin being relied upon in the rejection, the Examiner has

17   essentially extended Appellants an invitation to engage in mind reading and/or guessing to

18   determine how the Examiner is interpreting the elements of the claims and what specific features

19   within Conklin the Examiner believes identically disclose the claimed invention.

20

21   As noted by the Supreme Court in <u>Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki</u>

22   <u>Co.</u>,[7] a clear and complete prosecution file record is important in that "[p]rosecution history

23   estoppel requires that the claims of a patent be interpreted in light of the proceedings in the PTO

24   during the application process." The Courts that are in a position to review the rejections set

25   forth by the Examiner (i.e., the Board of Patent Appeals and Interferences, the Federal Circuit,

---

[7] 535 U.S. 722, 122 S.Ct. 1831, 1838, 62 USPQ2d 1705, 1710 (2002).

1 and the Supreme Court) can only review what has been written in the record; and therefore, the

2 Examiner must clearly set forth the rationale for the rejection and clearly and particularly point

3 out those elements within the applied prior art being relied upon by the Examiner in the

4 statement of the rejection.

5

6 Essentially, the Examiner is placing the burden on Appellants to establish that Conklin

7 does not disclose the claimed elements based upon Appellants' interpretation of the claims and

8 Appellants' comparison of the claims with the applied prior art. However, this shifting of

9 burden, from the Examiner to Appellants, is premature since the Examiner has not discharged the

10 initial burden of providing a prima facie case of anticipation. Appellants also note that any

11 continuing disagreement between Appellants and the Examiner as to whether or not a particular

12 claimed feature is disclosed by Conklin is a direct result of a lack of specificity by the Examiner

13 in the statement of the rejection.

14

15 On pages 7 and 8 of the Second Office Action, the Examiner reproduced portions of

16 paragraphs [0025] and [0096] of Appellants' disclosure[8] and asserted the following on page 7 and 8:

17   With regard to applicant applicant's argument that Conklin does not disclose, "the
18   contract is generated is two separate storing steps, a generating step, and an interlocking step.", the
19   Examiner respectfully disagrees. After a thorough search of applicant's specification, Examiner
20   has found only two references to "interlocking":
21
22   [citations to paragraphs [0025] and [0096] of Appellants' disclosure omitted]
23
24   neither reference clearly defines "interlocking" differently than an ordinary meaning, found in any
25   dictionary.
26
27   [graphical representation of text omitted]
28
29   1.   To unite or join closely as by hooking or dovetailing.

---

[8] The label, by paragraph number, is found in U.S. Patent Publication No. 2002/0046081, which corresponds to the present application.

1   2.   To connect together (parts of a mechanism, for example) so that the individual parts
2   affect each other in motion or operation.
3
4   Therefore, when construing the claim consistent with MPEP §2111, Examiner is able to give the
5   claim its broadest reasonable interpretation consistent with the specification. Here, the Examiner
6   interprets "a generating step, and an interlocking" to mean that the rules have been generated and
7   then joined.
8

9   The Examiner's "claim construction" suffers from several deficiencies. For ease of reference, the

10   particular limitation at issue is "interlocking the compilation of business rules, the terms and

11   conditions set and the links <u>to lock the contract</u>" (emphasis added). The Examiner's "thorough"

12   search of Appellants' specification missed paragraph [0095],[9] which is reproduced below:

13   When final revisions of all contract elements are approved by negotiating parties, all
14   elements are <u>interlocked</u> by the seller contract administration staff to <u>prevent further changes to</u>
15   <u>the contract</u>, as shown in FIG. 8. The contract is locked, for example using conventional digital
16   signature techniques or otherwise, to <u>lock</u> all contract elements including the designated Ts&Cs
17   Set and the Product List Filter, and is registered by the seller's administrator as a signed contract.
18   Thereafter, the Static Elements of the contract may be amended only by mutual agreement
19   between the parties, in the manner illustrated in FIG. 9. (emphasis added)
20

21   Referring both to the claim language at issue and to paragraph [0095], the interlocking acts to "lock

22   the contract," which prevents further changes to the contract. In this regard, reference is made to the

23   following dictionary[10] definitions:

24   *intransitive verb*
25   : to become locked together or interconnected
26   *transitive verb*
27   1 : to lock together : UNITE
28   2 : to connect so that the motion or operation of any part is constrained by another.
29

30   Based upon these dictionary definition; the claimed phrase, *as a whole*; and with Appellants'

31   specification, Appellants' position is that one having ordinary skill in the art would not interpret

32   "interlocking" to merely mean "joined," as alleged by the Examiner. Instead, one having ordinary

33   skill in the art would have read the term "interlocking" in conjunction with the phrase "to lock the

34   contract." Moreover, comparable to when two objects become interlocked so that one prevents

---

[9] Paragraph [0095] also corresponds to lines 1-7 on page 25 of Appellants' disclosure.
[10] http://www.merriam-webster.com/dictionary/interlock.

1   movement of the other, the interlocking of the compilation of business rules, the terms and

2   conditions set and the link locks this compilation of contract elements to prevent movement (i.e.,

3   changes) to the compilation of contract elements. Thus, Appellants respectfully submit that the

4   Examiner has relied upon a flawed claim construction.

5

6   Moreover, Appellants note that the Examiner's own claim construction is overly broad

7   based upon the Examiner's own dictionary definition. The Examiner cites to two different

8   dictionary entries. However, the first entry is inappropriate since this definition refers to

9   physical joining (i.e., by hooking or dovetailing), which is not comparable to the language of the

10   claims. The Examiner's second definition does not simply refer to "joining" but to joining "so

11   that the individual parts affect each other in motion or operation." The Examiner's analysis,

12   however, is silent as to the "so that the individual parts affect each other in motion or operation."

13

14   Since the Examiner's analysis is based upon a flawed claim construction, Appellants

15   respectfully submit that the Examiner has failed to establish that Conklin identically discloses all

16   of the claimed limitations. Moreover, Appellants note that the Examiner has still failed to

17   specifically identify, within the applied prior art, teachings allegedly identically disclosing each

18   of the claimed limitations recited in claim 1. Appellants, therefore, respectfully submit that the

19   imposed rejection of claims 1, 3, 5-11, 13-19, 21-25, 27, 29-35, and 37-40 under 35 U.S.C. § 102

20   for anticipation based upon Conklin is not factually viable.

21

22   <u>Claim 3</u>

23   Although Appellants did not present any arguments with regard to claim 3 in the First

1 Appeal and in the present, Second Appeal Brief, claim 3 (and its counterparts) stand or fall

2 together with claim 1, Appellants wish to address the Examiner's newly presented arguments on

3 pages 8 and 9 of the Third Office Action. Notably absent from any of the Examiner's analysis is

4 a specific reference to any of the claim language. Instead, the Examiner appears to have "cut and

5 paste" these arguments from somewhere and inserted them without regard to exactly how these

6 arguments relate to the actual claim language.

7

8   Referring to specifics of the claim at issue, claim 3 recites representation criteria

9 comprising product section criteria products exclusions criteria. Based upon a plain reading of

10 these terms, these limitations are functional in that they limit (i.e., employ a criteria) the use of

11 data. Thus, contrary to the Examiner's unstated assertion, claim 3 does not recite nonfunctional

12 descriptive material. Moreover, claim 3 recites that the communications interface displays a

13 filter product list. This limitation also not directed nonfunctional descriptive material. Thus,

14 Appellants' position is that the Examiner's analysis on pages 8 and 9 of the Third Office Action is

15 not germane to the claim limitations recited in claim 3.

16

17   Conclusion

18   Based upon the foregoing, Appellants respectfully submit that the Examiner's rejections

19 under 35 U.S.C. §§ 101, 102 is not viable. Appellants, therefore, respectfully solicit the Honorable

20 Board to reverse the Examiner's rejections under 35 U.S.C. §§ 101, 102.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: June 29, 2008

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VIII. CLAIMS APPENDIX

1. A system for workflow control of contractual activities under a contract comprising a predefined set of terms and conditions, comprising

a computer for storing the contract terms and conditions, receiving information, and referencing the terms and conditions of the contract to process the information and generate a user interface in response, and

a communications interface for communicating the user interfaces to a contracting party, wherein

the user interface displays selected information based on terms and conditions in the contract, and

the contract is generated by:

storing at least one compilation of business rules comprising a plurality of rules available to be selected for inclusion in the contract,

storing at least one terms and conditions set containing parameters corresponding to selected rules from the compilation of business rules,

generating links between the compilation of business rules and the terms and conditions set to generate specific terms and conditions to be embodied in the contract, and

interlocking the compilation of business rules, the terms and conditions set and the links to lock the contract.

3. The system as defined in claim 1 in which the contract contains representation criteria comprising product selection criteria or products exclusion criteria, or both, and the communications interface displays a filtered product list comprising a subset of products from a master product list.

5. The system as defined in claim 1 in which the computer further stores at least one product list filter for generating a list of a specified subset of products from a master list of products, and generates links between the product list filter, the terms and conditions set and the master list of products.

6. The system as defined in claim 5 in which the product list filter comprises a plurality of tiers, each tier generating a list of a different subset of products.

7. The system as defined in claim 5 in which the contract comprises dynamic elements which can be unilaterally altered by a contracting party.

8. The system as defined in claim 7 in which the product list filter is a dynamic element.

9. A method of workflow control of contractual activities under a contract comprising a predefined set of terms and conditions, comprising the steps of:

a. storing the contract terms and conditions, receiving information, and referencing the terms and conditions of the contract to process the information and generate user interfaces in response, and

b. communicating a user interface to a contracting party, wherein

the contract is generated by

storing at least one compilation of business rules comprising a plurality of rules available to be selected for inclusion in the contract,

storing at least one terms and conditions set containing parameters corresponding to selected rules from the compilation of business rules,

generating links between the compilation of business rules and the terms and conditions set to generate specific terms and conditions to be embodied in the contract, and

interlocking the compilation of business rules, the terms and conditions set and the links to lock the contract.

10. The method as defined in claim 9 in which the user interface displays selected information based on terms and conditions in the contract.

11. The method as defined in claim 9 in which the contract contains representation criteria comprising product selection criteria or products exclusion criteria, or both, and the user interface displays a filtered product list comprising a subset of products from a master product list.

13. The method as defined in claim 9 including the further steps of storing at least one product list filter for generating a list of a specified subset of products from a master list of

products, and generating links between the product list filter, the terms and conditions set and the master list of products.

14. The method as defined in claim 13 in which the product list filter comprises a plurality of tiers, each tier generating a list of a different subset of products.

15. The method as defined in claim 13 in which the contract comprises dynamic elements which can be unilaterally altered by a contracting party.

16. The method as defined in claim 15 in which the product list filter is a dynamic element.

17. A computer program product for use with a computer, the computer program product comprising a computer usable medium having computer readable program code embodied in said medium for workflow control of contractual activities under a contract comprising a predefined set of terms and conditions, said computer program product having

a. computer readable program code for storing the contract terms and conditions, receiving information, and referencing the terms and conditions of the contract to process the information and generate user interfaces in response, and

b. computer readable program code for communicating the user interfaces to a contracting party, wherein

the contract is generated by

storing at least one compilation of business rules comprising a plurality of rules available to be selected for inclusion in the contract,

storing at least one terms and conditions set containing parameters corresponding to selected rules from the compilation of business rules,

generating links between the compilation of business rules and the terms and conditions set to generate specific terms and conditions to be embodied in the contract, and

interlocking the compilation of business rules, the terms and conditions set and the links to lock the contract.

18. The computer program product as defined in claim 17 in which the user interface displays selected information based on terms and conditions in the contract.

19. The computer program product as defined in claim 17 in which the contract contains representation criteria comprising product selection criteria or products exclusion criteria, or both, and the user interface displays a filtered product list comprising a subset of products from a master product list.

21. The computer program product as defined in claim 17 including the further steps of storing at least one product list filter for generating a list of a specified subset of pro ducts from a master list of products, and generating links between the product list filter, the terms and conditions set and the master list of products.

22. The computer program product as defined in claim 21 in which the product list filter comprises a plurality of tiers, each tier generating a list of a different subset of products.

23. The computer program product as defined in claim 21 in which the contract comprises dynamic elements which can be unilaterally altered by a contracting party.

24. The computer program product as defined in claim 23 in which the product list filter is a dynamic element.

25. A processing system for workflow control of contractual activities under a contract comprising a predefined set of terms and conditions, comprising:

a storage module for storing the contract terms and conditions,

a receiving module for receiving information,

a reference module for referencing the terms and conditions of the contract to process the information and generate a user interface in response, and

a communications interface for communicating the user interfaces to a contracting party, wherein

the user interface displays selected information based on terms and conditions in the contract, and

the contract is generated by

storing at least one compilation of business rules comprising a plurality of rules available to be selected for inclusion in the contract,

storing at least one terms and conditions set containing parameters corresponding to selected rules from the compilation of business rules,

generating links between the compilation of business rules and the terms and conditions set to generate specific terms and conditions to be embodied in the contract, and

interlocking the compilation of business rules, the terms and conditions set and the links to lock the contract.

27. The system as defined in claim 25 in which the contract contains representation criteria comprising product selection criteria or products exclusion criteria, or both, and the user interface displays a filtered product list comprising a subset of products from a master product list.

29. The system as defined in claim 25 further including at least one product list filter means for generating a list of a specified subset of products from a master list of products, and links between the product list filter, the terms and conditions set and the master list of products.

30. The system as defined in claim 29 in which the product list filter comprises a plurality of tiers, each tier generating a list of a different subset of products.

31. The system as defined in claim 28 in which the contract comprises dynamic elements which can be unilaterally altered by a contracting party.

32. The system as defined in claim 31 in which the product list filter is a dynamic element.

33. A program product for use with a computer having computer readable program code for workflow control of contractual activities under a contract comprising a predefined set of terms and conditions, the program product comprising:

a. computer readable program code for storing the contract terms and conditions, receiving information, and referencing the terms and conditions of the contract to process the information and generate a user interfaces in response, and

b. computer readable program code for communicating the user interfaces to a contracting party, wherein

the contract is generated by

storing at least one compilation of business rules comprising a plurality of rules available to be selected for inclusion in the contract,

storing at least one terms and conditions set containing parameters corresponding to selected rules from the compilation of business rules,

generating links between the compilation of business rules and the terms and conditions set to generate specific terms and conditions to be embodied in the contract, and

interlocking the compilation of business rules, the terms and conditions set and the links to lock the contract.

34. The program product as defined in claim 33 in which the user interface displays selected information based on terms and conditions in the contract.

35. The program product as defined in claim 33 in which the contract contains representation criteria comprising product selection criteria or products exclusion criteria, or both, and the user interface displays a filtered product list comprising a subset of products from a master product list.

37. The program product as defined in claim 33 including at least one product list filter, computer readable program code for generating a list of a specified subset of products from a master list of products, and computer readable program code for generating links between the product list filter, the terms and conditions set and the master list of products.

38. The program product as defined in claim 37 in which the product list filter comprises a plurality of tiers, each tier generating a list of a different subset of products.

39. The program product as defined in claim 37 in which the contract comprises dynamic elements which can be unilaterally altered by a contracting party.

40. The program product as defined in claim 39 in which the product list filter is a dynamic element.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellants in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellants are unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.